

page 2, lines 1-2). First, the background section identifies the problem that present systems require a headset and traditional stationary personal computing to perform speech recognition for various reasons. (Applicant's Specification, page 1, lines 11-22). Second, the background section identifies the problem that present personal digital assistants (PDAs) have only a touch screen, not both a touch screen and an input device to receive voice commands. (Applicant's Specification, pages 1 line 23 to page 2 line 2). Thus, even though these may exist separately, there is still a need for the combination, because users find it less desirable to wear a headset and use a traditional stationary computer and more desirable to use a PDA with both a touch screen and an input device to receive voice commands. Furthermore, the claimed invention solves the identified problem by including both a touch screen and the ability to receive voice commands. For example, claim 4 recites "a mobile personal digital assistant having a touch screen . . . and an input stylus comprising . . . a microphone . . . for receiving acoustical voice signals." Therefore, Applicant denies that the claimed invention is in any way described in the background section, except in pointing out the need for it.

Consideration of the invention as a whole

Furthermore, saying the background section—which points out the problem—makes the solution obvious is improper hindsight. Incremental inventions are no less worthy of patent protection. "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." *In re Nomiya*, 41 USPQ 308, 311 (C.C.P.A. 1975). "The constitutional purpose is to encourage disclosure of patentable contribution to 'progress in the useful art', all the useful arts, not just the esoteric. The statute requires utility, novelty, and nonobviousness, not complexity." *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2d 1593, 1600 (Fed. Cir.), cert. Denied, 481 U.S. 1052 (1987). Applicant encourages reconsideration of the invention as a whole.

Ohashi and background section do not teach or suggest all claim elements

Claim 4 recites "a mobile personal digital assistant having a touch screen . . . and an input stylus comprising . . . a microphone . . . for receiving acoustical voice signals." Claim 8 recites "a personal digital assistant (PDA) having a touch screen display . . . and an input stylus comprising . . . a microphone . . . for receiving acoustical voice signals." Claim 12 recites "transmitting the voice signals from the hand-held stylus to the personal digital assistant." Ohashi does not teach or suggest these elements. Ohashi does not contain the words "PDA" or "personal digital assistant." As discussed above, the background section points out the problem to be solved by the claimed invention. However, the problem itself is not prior art. The solution to the problem is new and there is no motivation or suggestion to create the claimed invention in Ohashi. The background section, by definition, described the problem to be solved by the claimed invention and to use this problem definition to prove obviousness is impermissible hindsight. Therefore, claims 4, 8, and 12 are patentable under 103 over Ohashi and the background section. Since claims 5-7, 9-10, and 13-15 depend from patentably distinct independent claims 4, 8, and 12, these dependent claims are also patentable under 103 over Ohashi and the background section. MPEP 2143.03. Applicant requests reconsideration of claims 4-15.

Claim 7 is also Patentable under 35 U.S.C. §103

Claims 2 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohashi (U.S. Patent No. 5,581,783) in view of Applicant's Admitted Prior Art as applied to claims 1, 3-6, and 8-15 above, and further in view of Epperson (U.S. Patent No. 5,247,137).

Claim 2 was canceled in the Amendment and Response to the Second Office Action. The Amendment and Response was filed July 10, 2001 and the Second Office Action was mailed April 10, 2001.

Claim 7 depends from patentably distinct claim 4 and is thus patentable under 103 for the above reasons. Adding the power supply in Epperson does not change the fact that Ohashi and the background section do not teach or suggest the other elements. Epperson does not teach or suggest a mobile personal computing device which allows a user to enter information using both

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

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Title: POINTING DEVICE WITH INTEGRATED AUDIO INPUT

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Dkt: 884.078US1

a touch screen and voice commands. Epperson contains no motivation or suggestion to combine. Therefore, Applicant requests reconsideration of claim 7, also.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2160 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 29 day of October, 2001.

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